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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,764	11/18/2003	Michael Schwabe	DT-6633	5252
30377	7590	10/17/2005	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			AURORA, REENA	
			ART UNIT	PAPER NUMBER
			2862	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/715,764	Applicant(s) SCHWABE ET AL.	
	Examiner Reena Aurora	Art Unit 2862	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 32 is/are pending in the application.
- 4a) Of the above claim(s) 27 - 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 12, 17 and 19 - 26 is/are rejected.
- 7) ☒ Claim(s) 13 - 16 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicant's election without traverse of invention I (claims 1 - 26) in the reply filed on 09/30/05 is acknowledged.

Claims 27 – 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/30/05.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 12, 17 and 19 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Spies (4,612,502).

As to claims 1 – 8 and 12, Spies discloses a magnetic measuring instrument including a base body (1, not shown, fig. 1a, 1b) formed of a permanently magnetizable material and extending in a measuring direction, the base body having first (6) and second (5) sections alternatingly arranged one after another in the measuring direction and having, respectively, first and second magnetization directions, a position information being generated by a sensor (12) displaceable relative to the base body (12) in the measuring direction for scanning same, wherein the second sections (5) are formed by magnetically weak regions, and wherein the second magnetization direction

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magnetization direction of the second sections is defined by the first magnetization direction of adjacent first sections (col. 2, line 65 – col. 3, line 8 and col. 3, lines 34 - 36).

As to claims 9 - 11, Spies discloses that the magnetically weak regions (5) are defined by recesses formed in the base body (12) (col. 4, lines 41 – 43).

As to claims 17, and 19, Spies discloses that the base body (1, col. 2, lines 63 - 66) is formed as a one-piece part

As to claims 20 – 22, Spies discloses flux-guiding element (2d, fig. 5a) provided on one side of the base body (col. 4, lines 59 - 62).

As to claims 23 and 24, Spies discloses that the base body forms a graduation support for linear and angle graduation (col. 1, lines 7 - 10).

As to claims 25 - 26, Spies discloses a magnetic measuring instrument including a measuring graduation having a base body (1) formed of a permanently magnetizable material and extending in a measuring direction, the base body (1) having first (6) and second (5) sections alternating arranged one after another in the measuring direction and having, respectively first and second magnetization directions, with the second sections (5) being formed by magnetically weak regions and with the second magnetization direction of the second sections being defined by the first magnetization direction of adjacent first sections; and at least one sensor (12) displaceable along a longitudinal side of the base body (1) in the measuring direction for scanning same for generating position information (col. 2, line 65 – col. 3, line 8 and col. 3, lines 34 - 36).

***Allowable Subject Matter***

Claims 13 – 16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 13 and 14, the prior art fails to show the weak region when viewed in the measuring direction have a contraction in a middle region. This feature taken together with the other limitations of the claim renders the claims allowable over prior art.

As to claims 15, 16 and 18, the prior art fails to show a measuring graduation wherein the weak regions are one of continuously narrow and widen from one end to another end. This feature taken together with the other limitations of the claim renders the claims allowable over prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reena Aurora whose telephone number is 571-272-2263. The examiner can normally be reached on Monday - Friday, 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, E. Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Reena Aurora". The signature is written in a cursive, flowing style.

Reena Aurora